

## **REMARKS**

Claims 36-62 and 65-89 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent Publication No. US 2001/0049470 to Mault ("Mault") in view of U.S. Patent No. 6,736,759 to Stubbs et al ("Stubbs"). Applicant respectfully traverse this rejection. Claims 36-62 and 65-89 are pending. Claims 36, 50, 65, and 68 have been amended to clarify the preexisting scope of the claims. Claims 66-67 and 69-71 have been cancelled without prejudice. Applicant respectfully requests entry of the amendments. In addition, Applicant requests reconsideration of the rejections and allowance of the claims based on the following.

### **I. The Office Action Does Not Establish a *Prima Facie* Case of Obviousness of Claim 36**

The examiner has not made a prima facie case of obviousness. Section 2142 of the MPEP states "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." That same section further states "[t]he Federal Circuit has stated that rejections on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

#### **A. *A Prima Facie case has not been established because rational underpinnings to support the rejection has not been provided.***

##### **1. Wirelessly Transmitting Speed of Movement Output**

A *Prima Facie* case has not been established with respect to claim 36 because the rational underpinning to support the rejection has not been provided. On page 3 of the Office Action, it states "[i]t would have been obvious to use Stubbs means of transmitting a speed of movement, with Mault's device, as it is well known as taught by Stubbs, to transmit a speed of a user, for displaying, for displaying instantaneous speed." This is the only explanation provided for combining Mault and Stubbs.

Applicant points to at least two deficiencies in this explanation. First, the rationale is circular. It argues essentially that it would be obvious to modify the reference with feature "X" because the second reference discloses feature "X." This simply bootstraps the information in Stubbs to state that it would also be the reason for such a change.

Moreover, there is no objective reasoning provided to combine the references. MPEP Section 2143.01(IV) provides "[a] statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time of the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some **objective reason** to combine the teachings of the references." (emphasis added). There is no such objective reasoning provided by the Office Action. More specifically, the Office Action does not provide an objective reason why the system or device in Mault would be modified to wireless transmit the speed of movement output *and also to further modify* Mault to display the current speed of movement *given that* Mault does not display speed of movement on its wrist-device to begin with. Conclusory statement are not sufficient to establish a *prima facie* case.

## **2. Display Device and Storage Device**

Again, it is the Patent Office's obligation to provide some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

In the Office Action, on page 2, when discussing the primary reference, there is no supporting discussion with respect to the Mault describing the recited display device and storage device of claim 36. Thus, the Office Action concedes that such disclosure is lacking from Mault. On Page 3 of the Office Action, reliance is placed on Stubbs to disclose the recited display device and storage device. However, there is absolutely no explanation or supporting rationale for making such a modification (modifying Stubbs with the components identified by the Examiner of Stubbs). Therefore, a *prima facie* case of obviousness has not been established.

### ***B. Mault teaches away from being Combined with Stubbs.***

Mault teaches away from displaying current speed of movement, and consequently receiving the speed of movement output. Mault is directed to assisting people in weight loss through diet and activity monitoring. Mault describes a system that monitors the energy used and the caloric intake during a day. Monitoring device 10 of Mault is described to include a body activity monitor that "monitors some aspect of the subject's body activity allowing the person's total activity or caloric expenditure to be reasonably determined." Displaying speed of

movement on the wrist display in Mault wouldn't make sense because Mault is directed to weight loss. Modifying Mault to add a speed of movement display on the device in Mault may be detrimental and potentially risky as a dieter may seek to constantly increase the rate of her movement to lose weight quicker. Mault resolves this problem by displaying previously logged information on a user's PC. For example, Mault, specifically states "FIG. 5 shows a sample screen display from a local computing device such as a home computer." (Mault ¶ 40, see also ¶¶ 25, 27, 28.)(emphasis added.) The home computer is not moving with the subject and neither is the PC in any physical relationship with the subject.

In addition, further review of Mault indicates that Mault states repeatedly that it is directed to determining total calorie expenditure which focuses on a different approach than athletic training. The Mault system is directed to being worn all day to track daily total caloric expenditure.

Given the above, Mault teaches away from modifying the device in Mault to display speed of movement. In the Office Action, the response to Applicant's arguments states that the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. Applicant agrees with this statement. Accordingly, this means that **all** of the teachings from the references shall be considered including those teaching away as Applicant has described above. The Office Action does not explain how the combined teaching somehow rebut the explained teaching away in Mault. See MPEP Section 2141.03(VI) and MPEP Section 2141.02(II)("The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and *all teaching* in the prior art must be considered to the extent that they are in analogous arts." (emphasis added)).

***C. All the features of claim 36 are not disclosed by the combination of Mault and Stubbs.***

All the features of claim 36 are not disclosed by the Examiner's proposed combination of Mault and Stubbs. For example, the Office Action relies on Stubbs to disclose the recited display device and storage device. However, such reliance is misplaced. Claim 36 recites, among other things:

**a display device** that is *adapted to be worn on the wrist of the athlete* and is configured to *receive the heart rate output and the speed of movement output*, and to display the current heart rate identified by the

heart rate data sensor device and the current speed of movement identified by the speed data sensor; and

**a storage device** that is *adapted to be in a physical relationship with the athlete in which the storage device moves with the athlete's mobile athletic activity* and is configured to receive the current heart rate output from the heart rate data sensor device and the current speed of movement output from the speed data sensor device and to store a log of data representative of the current heart rate and the current speed of movement for tracking the mobile athletic activity for different sets.

Based on Applicant's review, Stubbs does not disclose the recited storage device. The Office Action, on page 3, relies on "display component 7" of Stubbs to disclose the recited storage device. However, "display component 7" is the display component, not the storage device. The recited display device is adapted to be worn on the wrist and the recited storage device is adapted to be in a physical relationship to move with the athlete. In addition, each receives speed of movement output and heart rate output and, more specifically, the storage device receives the speed of movement output from the speed sensor device and the heart rate output from the heart rate data sensor device. "Display Component 7" of Stubbs cannot be both the recited display device and the recited storage device. In other words, if the Examiner is relying on "display component 7" to disclose the recited display device, then Stubbs does not disclose the recited storage device of claim 36 and if it is relying on "display component 7" to disclose the recited storage device, then Stubbs does not disclose the recited display device of claim 36 given that the display device and storage device are each recited to *receive* the speed of movement output and the heart rate output.

The Office Action appears to concede this deficiency on page 9, in first full paragraph, in which the Office Action now relies on device 20 in Stubbs to disclose the recited storage device and further argues that "it is obvious that the data is first stored before transmitting." Applicant disagrees with this contention in that storing before transmitting is not an inherent feature of a transmitter. Moreover, the recited data storage device stores data for tracking the mobile athletic activity of different sets, and not some transient mark in the process of transmitting as would be the case in Stubbs. Accordingly, the reliance on device 20 is also misplaced.

***D. The Office Action ignores the modular language in the claim.***

Claim 36, as previously presented, included the language modular wireless network. The Office Action is lacking in that, based on Applicant's review, it does not address this aspect of the claim. To further clarify the claim, amendments are proposed in the above listing of claims.

Accordingly, based on the foregoing, the rejection of claim 36 should respectfully be withdrawn.

**II. A *Prima Facie* case has not been Established for Claims 37-49, 72-78, and 87-88**

The rejection of claims 37-49, 72-78, and 87-88, which are based from claim 36, should be withdrawn at least on the basis provided above with respect to claim 36.

**III. A *Prima Facie* case has not been Established for Claim 50**

***A. A Prima Facie case has not been established because rational underpinnings to support the rejection has not been provided.***

Applicant cannot identify where in the Office Action the obviousness rejection of claim 50 is provided. There appears to be a mention of a feature of claim 50 at the bottom of page 4 of the Office Action, but there is no identification of the claim number nor is there a discussion of a proposed modification, proposed combination, or any rational or objective underpinning to an obviousness conclusion. Withdrawal of the rejection is respectfully requested.

***B. All the features of claim 50 are not described by Mault and Stubbs***

All the features of claim 50 are not described by Mault and Stubbs. For example, similar to the discussion above with respect to claim 36, there is no description of the recited user interface device and data logging device of claim 50. More specifically, claim 50 recites, among other things, a user interface device that is configured to be worn on the user's wrist comprising a first wireless transceiver configured to receive information from another device worn or carried by the user and a data-logging device configured to be worn or carried by the user comprising a second wireless receive configured to receive information from another device worn or carried by the user. Generally speaking, as we understand the reference and the rejection, there is no description or suggestion of a modular personal network that includes, among other things, a user interface device, worn by the user, that has a first wireless receiver to wirelessly receive

information from another device worn or carried by the user) and also includes a data-logging device, worn or carried by the user, that has a second wireless receiver to wirelessly receive information from another device worn or carried by the user. For example, a runner would have a user interface on his wrist that wirelessly receives information while he or she is exercising from another device, for example on the user's leg, and also has a data-logging device, for example, on his arm, that wirelessly receives information from another device worn or carried by the runner such as on his head. Such a network is not described or suggested by Mault and Stubbs based on Applicant's review.

**IV. A *Prima Facie* case has not been Established for Claim 51-62, 79-86, and 89**

The rejection of claims 51-62, 79-86, and 89, which are based from claim 50, should be withdrawn at least on the basis provided above with respect to claim 50.

**V. A *Prima Facie* case has not been Established for Claims 65 and 68**

Based on Applicant's review all of the features of claims 65 and 68 are not described by Stubbs or Mault. For example, each of those claims includes features directed to simultaneously displaying heart rate and speed data using a personal computer. The Office Action appears to direct its reliance to Stubbs at col. 3, lines 6 – et seq. However, Applicant's review did not locate such a description in Stubbs.

In addition, the Office Action does not provide an explanation with rational underpinning for the obviousness rejection. Moreover, Applicant cannot even discern the proposed modification of Mault or Stubbs.

**VI. A *Prima Facie* case has not been Established for Claim 89**

Applicant added new claim 89 in the previous amendment. The present Office Action rejects claim 89 by only presenting a conclusory statement: "it would be obvious to have the global positioning system device, the heart rate monitor, the use interface device, and the data logging device are modular with respect to one another, given not unexpected results." As previously stated, conclusory statements are not sufficient to establish a *prima facie* case. The MPEP and the Federal Circuit have stated that the Office Action, among other things, requires an

explanation of the rational underpinning for the rejection, some objective evidence and not mere conclusory statements. *See In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006).

## **VII. Obligation of the Patent Office**

The code of Federal Regulations states under Section 1.104: "(b) Completeness of examiner's action: The examiner's action will be complete as to all matters." In the present Office Action, there are long strings of text essentially appearing to quote the claims in the present application without identifying the corresponding claim number to which the discussion applies. The Action is not complete in identifying to the Applicant the rejections by claim number. Moreover, the strings of text appear to be randomly alternating between Mault and Stubbs to preface a sentence or paragraph. This has made it difficult to understand the obviousness rejection presented and the reasons for the rejection. According, the Office Action does not meet the completeness obligation provided under Section 1.104. A new Office Action with clarifying text or a allowance of the Application is respectfully requested.

## **VIII. Conclusion**

Applicant believes that the Application is now in condition for allowance. The issuance of a notice of allowance is respectfully requested. The Examiner is invited to contact the undersigned if any additional information is required.

Respectfully submitted,

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